

T223

.V2 T5



T 223
-V2 T5

THE TRADE-MARK FILE OF THE U. S. PATENT OFFICE

ITS 2 VITAL DEFECTS AND THEIR CORRECTION

BY

HENRY C. THOMSON, Esq.
OF BOSTON

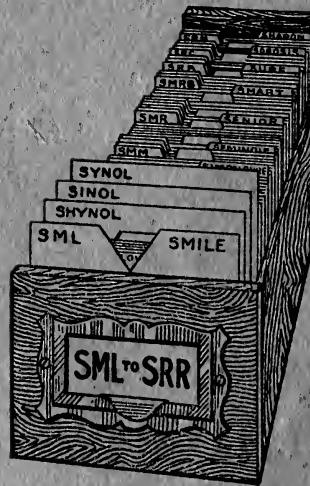
REPRINTED FROM THE

JOURNAL
of the
PATENT OFFICE
SOCIETY

5/9/22



Tray from the writer's "INDUSTRY" File
Class 39, "Clothing." Subclass "Hosiery."



Tray from the writer's "A to Z" FILE
Marks in Classes 1 to 49 from "SML" to "SRR"
(Note absence of vowels on guide cards)

Copyright, 1922, by Henry C. Thomson.

© CL A654330
JAN 20 1922

T 223
N 2 T 5

THE TRADE-MARK FILE OF THE U. S. PATENT OFFICE.

Its Two Vital Defects and Their Correction.

By HENRY C. THOMSON.

Author's Note. Inasmuch as a perusal of this article by persons, who are not thoroughly conversant with the present Patent Office conditions, may create a suspicion that my criticism is directed, in part, against the personnel of the Trade-Mark Division of the Patent Office, the writer considers it his bounden duty to state unreservedly that commendation rather than criticism should be extended to Chief Examiner Mead and his corps of Assistant Examiners, for their faithful and sustained efforts to surmount difficulties heaped upon this Division by an ungrateful, slothful, neglectful and parsimonious Congress which tolerates, unabashed, the doing of twice as much work for practically half as much pay by these hard working men and women. Betterments are constantly being sought by Examiner Mead. If he does not urge the adoption of my hobbies, the reader may be assured either that it is because he does not hold the same opinions as the writer, or considers that the necessary changes and additional files would be impracticable for installations in the Patent Office.

(Part I)

Vowel-Consonant Filing Faulty.

Late one Friday, the credit manager of a manufacturing concern became suspicious of the financial stability of an old customer, John Duley. He telephoned the shipping department, and asked if there were any undelivered orders for Duley, and after a short time was advised that there were none. On the following Wednesday John Duley went into voluntary insolvency, and that same afternoon shipping tickets were turned over to the billing clerk for goods shipped to John on the previous Monday, amounting to several thousand dollars.

As a result of the investigation that followed, it was learned that the head shipper had been absent on Friday;

23-3112

that the assistant shipper, a new man, unacquainted with the firm's customers, had answered the phone; that instead of consulting the name D-U-L-E-Y in the card catalogue, he had searched for D-O-O-L-E-Y; that since he has not found it in the files, he had reported, "no orders"; and also that the names commencing with D-O were in one box, while those commencing with D-U were in another. The investigation was not necessary to bring out that Duley sounded like Dooley over the telephone.

Where should we place the blame for the resulting loss, with the human or with the mechanical factor?

Before we attempt to answer this question, however, let us first change the story a little, substituting the Patent Office for the business institution, and brand names for sur-names.

Peter Smith was about to adopt the word RADIANT as the brand name for a preparation for cleaning wind shields and desired to have the exclusive right to use the name. Since Peter was a prudent man, he did not rely on his own observation and memory to warn him of possible prior use (as so many trade-mark adopters do), but employed a competent Washington Patent Attorney to search the records of registered trade-marks, filed in the Trade-Mark Division of the Patent Office, for evidence of possible prior registration of the word. In the course of a week Peter was advised that, although RADIANT had been registered for finger nail polish, it had not been registered for a glass cleaning material; and that, therefore, since the goods were not of the same descriptive properties, the prior registration was not conflicting, and Peter was not barred from using the name on his product and registering the word in the Patent Office.

Pursuant to this advice, the word RADIANT was adopted as a trade-mark, goods were manufactured, cartons ordered, catalogs printed, and a full page advertisement placed in the *Saturday Evening Pillar* to cost \$7000; and in each instance the mark RADIANT was prominently displayed. In order to secure the benefit of registration, an application was filed in the Patent Office.

On Friday, the thirteenth, a report was received by the prosecuting attorney from the Patent Office rejecting the application. The same day, Smith received a

letter from another attorney, couched in legal parlance, describing the dire consequences that would follow if his unlawful use of RADIANT did not instantly cease, since that was confusingly similar to RAYDIANT, the exclusive property of "my client." On consulting with his lawyer Smith also learned that his application had been refused because of the prior registration of RAYDIANT, for the same goods. The Patent Office Examiner was enabled to find that anticipatory word that escaped the patent attorney, because his personal file was confined to marks in but a single class; i. e. Class 4.

Who Is Responsible?

Where shall we place the blame in this case,—on the attorney who made the search, or on the trade-mark filing system of the Patent Office?

Suppose we charge the fault to the attorney who made the Patent Office "search" and note the reaction. He vigorously refutes the charge, contending that his responsibility ceased upon completion of the search and the report of the result with respect to the particular word submitted. In other words, that his responsibility did not extend to possible existence of every, or any, variations of RADIANT that might, or might not, be termed confusingly similar. His grounds for maintaining this contention were as follows:

(1) That the nominal charge made for trade-mark "search service" obviously confined the extent of the search to the spelling submitted by the client.

(2) That a trade-mark search service could reasonably be compared to a "preliminary examination" of an invention which was never expected to include investigation in every art where anticipation might be discovered.

(3) That he could not be expected to exercise his imagination with respect to possible variations, since this would put attorneys in a difficult situation; for, if a certain variation which did not occur to the attorney had been registered, the attorney would be open to a great deal of undeserved criticism.

"Therefore, the unfortunate results of this regrettable situation were not caused by any fault of mine," says the attorney in summing up.

Let us now imbue the filing system with life, and accuse it of negligence.

“My fault? Certainly not!” replies the filing system. “Have clearly in mind, if you please, that there are two systems for filing and indexing either surnames or brand names: (1) the ‘vowel-consonant’ system, which recognizes vowels, and (2) the “consonant” system which disregards them. The former may be regarded as a single-duty system, and the latter as a double-duty system.”

“The filing system which is used in the Patent Office, and which you blame for concealing instead of revealing the word RAYDIANT—a phonetical variation of the spelling RADIANT—is the vowel-consonant system. This requires that filing arrangement of words shall follow strictly the alphabetical sequence of letters, not merely with respect to the initial letter but to subsequent letters as well; otherwise, no assurance could be given that the file would reveal the word sought. Thus to file Duley with Dooley, or RAYDANT with RADIANT would be in violation of the rule. However, unless the rule is violated, neither of these words would be found when searching for the other; and unless the second word occurs to the searcher through the exercise of a fertile imagination it would be lost through its alphabetic difference. Therefore, it is indisputable that the sole function of the vowel-consonant filing system, as illustrated by the files of the Patent Office, is to disclose a previously *known* word, spelled one way only. And that duty is performed without criticism. But when it comes to asking this particular system to reveal promptly, or after much delay, or at all, all variations of a word phonetically spelled, or so spelled as to resemble the correct spelling, such a request is tantamount to asking the haystack to reveal the needle.”

So we must search elsewhere to place the blame, according to the filing system.

Fundamental Rule Responsible.

And now there comes a friend of both suspects who testifies that in his opinion neither the Patent Attorney nor the Patent Office is at fault, but that a fundamental rule of Trade-Marks is responsible for the unhappy re-

sult that the file conceals, rather than reveals, vitally important words. This rule is that *confusing similarity* between words as well as *identity* infringes. Were it not for this rule, searching for words possessing resemblance would be unnecessary, assuming they are filed accurately, and the vowel-consonant system would be fool-proof. In defense of this system, the friend adds that, although it must be admitted that neither RAYDIANT nor RHADIANT would be disclosed when searching for RADIANT in a vowel-consonant system, this objection is not important because of the rare occurrence of analogous instances.

Misspelled Words.

But here the writer must submit a little of his personal experience. Turn over with me the leaves of a bound volume containing the trade-marks registered in this country in 1900. Note how many pages we pass before we find a single word misspelled, either through careless spelling or in an attempt to spell phonetically. Now let us consult the marks published in 1921. By actual count we find more incorrectly spelled words in the first issue, that is, January 4th, than in the first six months of the year 1900.

What is the reason for the changed condition? Ask either the trade-mark adopter or his advertising manager, and you will be told that it is an attempt to make the trade-mark as attention-arresting as the advertising copy itself. One means of accomplishing this result is to misspell the trade-mark, for it causes the eye to telegraph to the brain that, for example, radiant is being spelled RHADIANT. The tendency of this subconscious mental deduction is that the observer will recall the word more readily at a later time.

In addition to intentional misspelling of dictionary words, there are the strictly coined words, or as the British Patent Office designates them "invented" trademarks, which are becoming increasingly popular. These two types of words present different problems when a search for confusingly similar words is instituted; for in case of the former type, the spelling of the word very frequently—or usually—suggests other possible forms of spelling, while coined words rarely—or seldom—give

a clue to other possibilities. Practically impossible of discovery by alphabetic methods are variations of spelling of the same word.

In the following list of Patent Office registered words, which have been selected from a group of many similar ones, the similarity of the second word is clearly suggested by the first. Every attorney should perhaps attempt to discover such variations even at the expense of being criticised for failing to educe those more difficult.

The reason for the use of both capitals and small letters will appear later.

ELBeeCo—ELPaCo	PaRaZoNe—PuRoZoNe
PuLeTeX—PiLeTeX	ReSiNoL—RoSoNaL
LuCeRNe—LuZeRn	RoLaX—RoLoX—RiLoX
PeNieL—PiNeal	ACMe—AKMe
CoQueTTe—CoZeTTe	

Of these words, PuRoZoNe would be the most troublesome to find when searching PaRaZoNe; but a trial of “P” followed by “e” “i” “o” “u” would disclose the “PuR” triplet, which pursued further would lead to “PuRo,” and finally PuRoZoNe.

Starting with either word in another group:

WiZ—WhiZ	NiPs—NiBs
PeMBiNa—PaMBiNo	PeNFLeX—PaNoPLiX
PiNoCKLe—PeaNoCKLe	PiNToFF—PaiNToFF
TRuPLeX—TRiPLeX	WaKe UP—WaCKe UP
PoLLeNe—PauLiNe	PuNJaB—PoNJap
TRiaNGLe—TReyeNGLe	DouGhBoy—DoeBoy

more thought would here be required to discover the similarity of its companion word; because, in searching the first word of the above couplets, failure to discover the companion word would be a natural mistake; for the tendency in searching is to commence with the known word and proceed in the direction of “Z.” If this course were followed here, the similar words would remain undiscovered, since only a search which commenced alphabetically *ahead* of the words as spelled would reveal them.

The possibility of three, or even four, words disclosing similarity is illustrated below. These words are necessarily distributed to different alphabetic positions in the Patent Office files:

PoSTeX—PaSTaX—PauSTiC
RaiNBoW—ReiNBo—ReMBo
PauSTiC—PaSTaX—PoSTeX
LouSeNe—LuCiNe—LewiSiNe—LueSan
PaiNiNe—PiNeNe—PheNiNe—PiNoN
PauLiNe—PoLeNe—PoLLiNe—PaaalLiN
SiNoL—SyNoL—ShyNoL—ShyNaL—ShiNe aLL

Reversing the positions of the first vowel and consonant, which follow the initial letter of a dictionary word, makes the companion word almost impossible of discovery, e. g.:

TaRPoN—TRaPoN

GaRDa—GRaDa

And then we have words with the same vowels but different consonants. Such words disclose differences in appearance but similarity in sound:

ITaTa—IDaDa

Such words are lost in the alphabetic differences of a vowel-consonant filing system.

There is vogue in trade-marks as well as in fashions. A present trade-mark vogue seems to be to omit either the first or second letter after the initial letter, for example:

BiLT for BuILt
VDo for VeDo
MRVeL for MaRVeL
HeLThwiN for HeaLThwiN

PaKt for PaCKeT
DLiGhT for DeLiGht
MStErDaM for MASTeRDAM

Could the first word in each couplet be hidden more effectually than by alphabetic filing? And yet, the searcher may be expected to be aware of the existence of such words. Let us repeat, that all of foregoing words are found in the files of the Patent Office.

The registration of "Cavalier" and "Chevalier," both for whiskey, words similar with respect to (1) sound, (2) appearance and (3) significance, the three tests for infringement, causes one to speculate whether or not "Chevalier" did not escape the Examiner's eye in searching for "Cavalier." And when we find "Cavalier" for shoes passed by the Examiner for publication, we are led to wonder why, since "CHEVALIER" already had been registered.

The Office records disclose neither opposition nor interference in either of these cases.

Another Aspect.

There is still another aspect of the matter of resemblance in trade-marks. Suppose, for the sake of example, that the companion marks in the foregoing illustrations be regarded as variations of each other, which are fair and are legally available for appropriation for goods of the same descriptive properties without infringement. If a prospective trade-mark adopter desires originality, it will not wholly satisfy him to know that he would be within the law in adopting one of these companion words, since he seeks wide differences rather than close resemblances. Therefore it is only half the story to advise a prospective adopter of a trade-mark that a word has not been registered if an even remotely similar word is either registered or published for the same products.

With this material at hand, we are now prepared to answer more intelligently the questions which have been propounded:

In the Dooley—Duley case, shall we blame the human or the mechanical factor?

In the Radiant—Raydiant affair, was the attorney at fault, or was the filing system defective?

If a workman is placed at an old fashioned machine, do we blame him or the machine, if the work falls below standard?

As there is but one answer to the last question, there can be but one to the first two, and that the same: in each of these cases the blame properly falls on the mechanical factor—the filing system; because the human factor cannot be expected to perform strictly mechanical acts, or to supply inherent mechanical defects in the tools at hand.

At this point, the reader may opine that the foregoing discussion is not very helpful, for the criticism is destructive rather than constructive; and ask, "Has the writer no specific panacea, whereby the discovery of similarity in word trade-marks may become mechanical, rather than mere chance and guess work?"

Filing by Consonants.

In answer he suggests the adoption, by the Patent Office, of a "Consonant" filing system for trade-marks.

This system has a distinct advantage over the single-duty “Vowel-consonant” system; for the former performs a double duty, in that it reveals under the same index heading, (1) the *known word*, and (2) any similar *unknown* variants, if such are in the filing system; while the latter system definitely reveals only the *known* word. This double-duty of the “Consonant” system is essential to a trade-mark filing system, if the most interested party, the trade-mark adopter and user, is to receive what he really desires and needs, when he requests that a “search” of a trade-mark be made for him; although he may not be aware of the vital importance of the information revealed by the “double-duty” system. The advantage of such a system to the attorney, however, is too apparent to require extended explanation. It is enough to say that the disclosure of confusing similarity often constitutes evidence upon which a case may turn.

To illustrate the thorough simplicity of the system, the writer has a few illuminating examples taken from his own experience in searching his personal files of Patent Office registered trade-marks, filed and indexed under the “Consonant” system, and tested for several years.

Suppose a client requests a search of the word “ECHO.” I look for the guide card EC, and behind this card I find not only the word ECHO, in all the different classes in which it is registered, but also ECO, ECCO, EKO and EKKO (the letter K is treated as the equivalent of the letter C, and double letters are treated as if they were single). Obviously, these words are confusingly similar, and should be communicated to the client, if in the same class. If the word sought had been EChoMo, I should have looked behind the guide card ECM; similarly, EChoMoD would be behind card ECMD.

From this illustration, the reason for the capital consonants and small-lettered vowels in the preceding groups of words will be evident; for, in the “Consonant” system, vowels are disregarded except where they are the initials letters of words.

In order to exemplify a few of the countless possible combinations of certain consonants connected by various vowels, to create coined words, let us use trade-marks either published or registered, having the key letters PRLN:

P R L N

Pa Ra Li N
Pa Ra LioN
Pe Ro Li N
Pe R Li Na
PeaR Li Ne
Power Li Ne
P Ro La N
Pu R Lai Ne
Pu Ro Le Ne
Pu Ro Li Ne
Py Ra Li N
Py Ro Li N

When creating coined words for clients, the writer frequently first selects the consonants to produce certain phonetic results, then draws these letters, separated from each other, in vertically extended form, and fills in different vowels until a suitable word is produced. It is interesting to conjecture the number of words based on *P R L N* that will be found registered, say in 1950; and also the number that will be published but unregistered, waiting to destroy some one's fond hopes.

The following list may give the reader some idea of the efficiency that the writer secures in a search of his own files compared with a search in the Patent Office files. Taking the words in the first column which would be found in the same tray, behind the guide card SML in the writer's files using the "Consonant" filing system, let us see how they are scattered in the filing drawer in the Trade-Mark Search Room of the U. S. Patent Office. Calling the drawer in which the first word is found No. 1, note the number of drawers that intervene between the different words, and particularly between the first and last words:

Patent Office Location of Words.

Word Filed	Drawer Designation	Drawer Number
SAMOL	SAM to SAMSON	1
SANOL	SANITEN to SANTI	4
SANOLA		
SEMOULE	SEM to SENSA	18
SENNOL		
SINOL	SIMPLE to SIRE	33
SINULA		
SOMNAL	SOM to SORO	43
SUNOL	SUNG to SUNQ	75
SUNOLIO		
SYNOL	SYLANS to SZZ	83

The writer will be surprised if this disclosure does not call forth the remark, "How can the attorney, asked to search any one of these words, be reasonably expected to find the rest of them in the Patent Office file, and other combinations of SML which may later be either published or registered and filed perhaps in other drawers?"

Not Fool-Proof.

"But, is this 'Consonant' filing system fool-proof?" some one asks, "Are there no traps?"

And here it must be admitted that there is one fault with this system. If, for example, a client wishes me to search the word PaNDoMiN for Corsets, I first look behind the guide card PNDM in the "Consonant" file and find every word having that combination of consonants. But if the word PLaNDoMiN for Corsets, obviously confusingly similar, should be filed, it would be hidden behind card PLND, and would not be found in my search of PNDM. The "Vowel-Consonant" system is, however, no better off than the "Consonant" system in this respect.

The question which would naturally follow: "How do you provide against such a contingency?" may be answered by describing another file, which the writer calls his "Industry" file. In this file, distinct from the "Consonant" file and complete in itself, Patent Office trademarks are filed separately according to the forty-nine classes designated by the Patent Office, and also, in some instances, into convenient sub-classes. The words in this file are placed alphabetically behind cards indexed with the single initial letter of the word. By subdividing the large classes, it is the exception to find more than two hundred words behind any index card.

If, then, PLaNDoMiN had been registered for corsets, and missed in searching "PaNDoMiN in the "Consonant" file, it would be found behind the index card "P" in searching PaNDoMiN for corsets in the CORSET subdivision of "Class 39, Clothing," in the "Industry" file. Hence, with careful filing and indexing, the "Consonant" file, supplemented by the "Industry" file, is mechanically fool-proof.

Conclusion.

Therefore, in a brief conclusion to the discussion of the first defect, we submit that the Patent Office trademark file is vitally defective for the reason that it is a "single-duty" system, and consequently, is inflexible and fails to disclose confusingly similar words; whereas, a complete search requires a "double-duty" system, one that will not only disclose the searched word as spelled but also disclose alphabetic variants. The "Consonant" filing system fulfills the obligation.

THE TRADE-MARK FILE OF THE U. S. PATENT OFFICE.

Its Two Vital Defects and Their Correction.

(Part II)

Importance of Filing "Published" Marks.

Now let us consider the second defect.

A new sales manager in a large jobbing concern desired to learn whether the different stages in the progress of orders through the establishment were functioning efficiently. He selected for investigation the stage at which the orders were transferred from the credit department to the shipping room; and requested a clerk to locate a certain order. The clerk replied, "We have no means of finding this order except that of hunting through the thousands of orders which are being laid out by the order clerks."

"Do you mean to say that you have no file for this purpose?" asked the manager.

"None at all although we need one badly," was the answer, which drew from the manager a remark more forcible than elegant.

Was the practical impossibility of locating the order after it had been accepted and passed on by the credit man a defect in the order system?

Let us turn now from the commercial to the legal aspect of a situation with respect to trade-marks.

Somebody Blundered.

One day, several years ago, a client thrust a copy of the OFFICIAL GAZETTE upon the writer's desk, and told me his tale of woe in a voice trembling with emotion and anger.

"You wrote me," he said, "that my trade-mark was not registered in the Patent Office by any one. Here is

the mark registered by a competitor. My mechanical engineer found it. What are we going to do now? Our preparations are all made to sell the goods under this name."

I tried to pacify him; told him that the mark his engineer had discovered was not registered, but merely published, i. e. pending registration; explained the object of publication, but failed to convince him that his unfortunate situation was not the result of some delinquency on my part.

His parting words were: "This announcement—I call it a registration—is at least a public record. You get this book; why didn't you see the word?"—as if, because I once saw it, as it passed before me in perusing the GAZETTE, I could be reasonably expected to remember the particular mark my future client was interested in from among the tens of thousands of published marks covering a period of years.

The irony of this unhappy incident has been brought home most forcibly to the writer, for it has fallen to his unhappy lot to observe the publication of several trade-marks applied for in behalf of his erstwhile client, and placed through a patent attorney who consults the writer's own file of registered and pending registration marks in making his reports regarding the registrability of these very marks.

Shall we say that the fault was mine that my client was originally placed in such an unfortunate predicament? or, can we blame the Patent Office because of its failure to place within reach of a prospective applicant information regarding marks "pending registration"—for, can it be denied that such information is as important as a knowledge of marks actually registered, or, under certain conditions, even more important?

Strange to say, neither the prospective trade-mark adopter, nor patent attorneys generally seem to fully appreciate the benefits to be derived from a complete file of published marks, from the year 1905 when publication commenced up to the current issue of the GAZETTE. As a consequence they do not notice the absence of these benefits. They may attach much importance to a registered mark, and yet disregard as negligible a mark "published" on the same date. However, it is the writ-

er's contention that knowledge that a mark is in the latter condition is even much more helpful and necessary to the applicant, under certain conditions, than the mere appreciation that a mark is, or is not, registered.

Rejection vs. Interference.

To illustrate, suppose a prospective registrant files an application for a trade-mark. If the Examiner finds the word to be already registered, the application is rejected, and the incident closed. The applicant loses only the cost of his application (and this loss could have been prevented if a search had been made). But what is the result if a conflicting mark happens to be in the stage "pending registration," that is, published but not issued? In such case, the application is not rejected forthwith, but is held for interference proceedings; and the applicant becomes a party to the interference,—often an unwilling party. His use of the word is disclosed to a concern in the same line of business, and, if his claimed date of first use is subsequent to that of the preceding applicant, *prima facie* he is an infringer. He has this expense in addition to the cost of his application, and perhaps he will have to destroy many cartons and labels already prepared, and reconstruct an advertising campaign if he is convinced that the prior applicant was the first user. Strange to say none of this expense could have been saved by a search of the Patent Office files, for the unregistered "pending registration" word would not have been found; therefore when we are determining the causes of this needless expense, we cannot overlook the fact that the Office is virtually concealing the conflicting mark, which it has already publicly revealed through publication, by its failure to subsequently make it accessible.

Very striking and conclusive evidence in support of the writer's contention could be adduced if the reproductions of all the published but unregistered marks printed in the *GAZETTE* were clipped individually and impaled upon a pin. How long would the pin be? We shall see. The clippings would then include marks pending registration, marks published for the purpose of interference and opposition, and those pending placement in the files

of the Search Room. If the reader were then asked to find the clipping upon which appeared the words "ONLY ONE" as applied to a dyspepsia remedy (pardon the levity), how many clippings would he need to remove from the pin, if the word were at the bottom?

Let us use once more the issue of the GAZETTE for Jan. 4, 1921 in order to obtain data that will help us to answer this question. In the numerical listing of trademarks registered weekly, there is also printed the date on which each mark was "published." Therefore, in the tabulation below, we find the date of publication of all marks registered on Jan. 4, 1921, together with the number of marks published on that date, and also the number of weeks which have elapsed since the date of publication, in summing up, we have the aggregate number of elapsed weeks for all the marks in the list:

Publication Data re Trade Marks Registered Jan. 4 1921.

Date of Publication	Number of Marks	Elapsed time in weeks	Total elapsed time
March 20, 1917	1	198	198
May 29, 1917	1	189	189
Aug. 5, 1919	1	75	75
Aug. 26, 1919	1	72	72
Nov. 18, 1919	1	60	60
Dec. 23, 1919	1	54	54
Mar. 2, 1920	1	44	44
June 1, 1920	1	31	31
June 15, 1920	1	29	29
July 6, 1920	4	26	104
July 13, 1920	9	25	225
July 20, 1920	5	24	120
Aug. 3, 1920	1	22	22
Aug. 10, 1920	15	21	315
Aug. 17, 1920	2	20	40
Aug. 24, 1920	11	19	209
Aug. 31, 1920	3	18	54
Sept. 7, 1920	20	17	340
Sept. 14, 1920	112	16	1792
Sept. 21, 1920	2	15	30
Sept. 28, 1920	1	14	14
Total elapsed time in weeks			4017

If we now take from this table the grand total of 4017, which represents the entire number of weeks which have intervened between the date of publication and the date of registration for all marks registered on Jan. 4, 1921, and divide it by 195, the total number of marks regis-

tered on this date, we have a quotient of 20. If to this quotient we add the average delay in filing copies of registered marks in the drawers of the "Search Room" of the Patent Office—about three weeks—we have now arrived at a "constant" of 23, which represents the average time in weeks intervening between the date of publication and the date on which a copy of the registration is placed in the Patent Office files for the purpose of "searching," that is, nearly six months, during which time practically 5000 trade-marks applied for have been concealed from view. In order to determine the number of clippings on the pin we must multiply this "Constant" 23 by 195, which represents the average number of registrations per week. The product is 4485; therefore, the reader would have to examine that number of clippings before coming to the trade-mark "ONLY ONE" for dyspepsia tablets. It is estimated that the pin would have to be more than two feet long to hold all the clippings.

It will be noted that the registration first listed was published March 20th, 1917. This means that while for a period of nearly four years a "search" conducted in the Trade-Mark Search Room of the Patent Office relative to the trade-mark "GEARLIFE" would of necessity cause both the attorney and his client, to assume that the word was open to exclusive appropriation, and furthermore, that if registration was applied for the application would, in absence of opposition or interference, have an assured, if snailpace, journey through the tortuous paths leading to the ultimate goal, the fact is, that neither assumption would be correct. And the pity is, that close at hand, as the search was being made, reposed the documentary evidence that at once would have disabused the searcher's mind of such erroneous assumptions.

The lesson to be learned from this little story is that, if a prospective trade-mark adopter desires to be informed with respect to possible "anticipation" among "pending" as well as "registered" trade-marks (and it is believed that this request would be almost universal, if it were known that such is both necessary and obtainable), the "search" necessarily should include not only marks registered in the Patent Office, but also marks

published in the GAZETTE for a period of several years prior to the date of the search. In spite of this, however, the Patent Office provides no means to assist the searcher, except the indiscriminate, helter skelter listing of marks in the weekly GAZETTE.

In this regard, a few more illustrations from the writer's practice would, perhaps, be enlightening. A client recently requested that a "search" be made of the word "Ambassador" for candy. Reference to the Patent Office file indicated that this word had not been registered for candy; but when the writer consulted his file of published marks, he found two applications for "Ambassador" for candy, which proved after investigation, to be in interference. Both marks were published in the GAZETTE of May 31, 1921, pages 1021 and 1023.

Another instance: In searching "Country Club," the Patent Office file showed no prior registration of the mark for ice cream; whereas, the writer's file of published marks disclosed that this word couplet had been published in the GAZETTE of Aug. 26, 1919, page 604, and also in the GAZETTE of Aug. 31, 1920, page 959, for the same goods.

Owing to the unfortunate condition created by the failure of the Patent Office to file published marks, both AMBASSADOR and COUNTRY CLUB were presumably open to registration, as far as the Patent Office Trade-Mark file is concerned, notwithstanding the prior publication of both marks in the OFFICIAL GAZETTE. Either of these marks would have stood as a bar to registration of the same or a confusingly similar mark for the same goods, until after the termination of the interference proceedings, since instructions have been given in each case to file applications if no anticipation was found.

Should the government, with its immensely profitable Patent Office Trade-Mark department, be permitted to thus deceive the innocent searcher of trade-mark information?

Prospective Applicants Deceived.

As a further result of the failure of the Patent Office to file "publications," the prospective applicant finds

himself in a particularly unfortunate position whenever *both* parties to an interference proceeding either mutually agree to withdraw their applications or fail to contest their cases. If thereafter, a third application for the same word was filed in the Office for the same goods, the Examiner would not reject it, because the prior applications are no longer pertinent; but it may reasonably be presumed, that the applicant would soon find himself a party to an opposition proceeding. Unacquainted with the publication of these marks, his handicap would be this, that he would be unable to obtain, from any listed source, any knowledge of the prior application or any evidence as to the date of first use as claimed by his presumptive opponents.

If the prospective adopter *did* have the benefit of this information, through the publication of the claimed dates of first use, he could either file his application or withhold it, depending upon whether after investigation he found his own date of first use to be prior or subsequent to the applicants in controversy. Of two published marks for the same goods neither of which have matured into registration the following is an example:

“HIGH ART” for mens’ shirts; Nov. 30, 1915, OFFICIAL GAZETTE, page 1703, first use Sept. 1913.

“HIGH ART” for mens’ shirts; Mar. 10, 1914; OFFICIAL GAZETTE, page 567; first use Dec. 1, 1911.

It is also very disconcerting to both attorney and client alike to file an application for registration, accompanied by a request that an interference be entered against a registered mark, and then later to have the Examiner of Interferences report that there is still another party to the interference whose mark has been published, and whose claimed date of first use is prior to that of both the registrant and the subsequent applicant.

Filing and indexing “published” marks would preclude the possibility of such surprises, since attorneys would have means of discovering such unlooked for claimants and could verify the dates given.

An “Interference” Pitfall.

An oft occurring “Interference” pitfall is dug when two applicants are in interference with respect to cer-

tain products, but not as to others; and the most zealous attorney, who uses the Patent Office file of "Registered" marks to conduct his search, cannot protect a prospective applicant from a tumble. The situation may be explained by a concrete illustration:

"JACK AND JILL" was registered for Rompers and Hosiery. A subsequent applicant filed an application for the same trade-mark for Creepers, Rompers, Outer Garments, Underwear, Hosiery and Shoes. A third party also filed an application for Garters and Waists. Thus the public was put on notice, by means of "publication" of these applications, that, in addition to Inner and Outer Garments and Hosiery, also Garters and Shoes were being sold under the trade-mark "JACK AND JILL." And then what happened to this valuable "published" information? Is there any clearer way of expressing it than to say that it was "shuffled into the discards," and thereby made practically inaccessible to both the attorney and his client and also to the trade-mark adopting public generally. This condition was recently disclosed to the writer through searching "JACK AND JILL" for Shoes and finding it in his personal file of published marks.

Eventually the interference with respect to the conflicting goods will be decided, (it was pending when this article was written). Until such time Garters and Shoes will continue to be pitfalls ready to trip the innocent applicant for registration of "JACK AND JILL" for these goods.

Then, there is the situation in which the prior user successfully opposes a "published" mark, but fails to register himself. Should another applicant, unaware of the two prior parties in controversy, file an application, he would probably be opposed by the opposer of record; whereas, if the publications of the first application had been placed on file, facts might have been disclosed which would have deterred the second applicant from filing.

Again, suppose the Office inadvertently passes to publication an application seeking to register a mark for many products, in Class 6 or 46 for example, when the same mark had already been registered for but *one* of those products. Or, suppose that, although the particular description of the applicant's goods differ from that

recited in a previous registration, the goods have the same descriptive properties, and the registrant in each case files a notice of opposition; if the applicant then fails to file his "Answer," the Office rejects the application. In either of these circumstances concerns in the trade have lost the benefit of this information conveyed by the publication concerning the products sold and dates of first use, as claimed by the applicants, because "Published" marks are not filed and indexed by the Patent Office; and so too is the knowledge of products lost in every case where a "Published" mark fails to mature into registration.

Published trade-marks which never mature into registration are sometimes helpful as an index with respect to the scope of trade-mark rights as viewed through the registrant's eyes. For example: the word "Cottolene" was applied for, the products being animal-feed meal. Obviously these products are of different descriptive properties than cooking fat, nevertheless, the prior user of the word believed that registration would damage him and opposed registration.

There are yet other objectionable features of the Patent Office Trade-Mark filing system which, although not strictly within the scope of this article, the writer takes the liberty of mentioning at this time. One is the loose filing of trade-mark copies in the filing drawers. The regular practice of perforating and running a string through the copy, and then fastening the string ends, with a lead seal is as slow and clumsy a method as can be imagined; however it is quite in keeping with the old saw that a barber's child seldom has his hair cut.

These copies are open to the inspection of the public *without supervision*,—a practice which is unwise to say the least. I have found as many as 200 loose copies in one drawer, reposing behind the bound copies. The opportunity for replacing copies incorrectly is thus ever present, not to mention the possibility of removal entirely.

Piecemeal Filing.

As a matter of general information it may be stated that copies of registered trade-marks are present under

three conditions in the Search Room. Those registered from 1881 to 1916 are tied together in the respective drawers where they repose. Copies from 1916 to 1919 are loosely placed behind the tied copies. While, unknown to many attorneys, copies from January 1, 1919 to date are in files separate from the regular file.

In two instances, previous to the completion of my own files, I discovered that copies were missing from the Patent Office files, and recently a picture trade-mark could not be located. Obviously, this is the result either of an error of the filing clerk, or an unconscious failure, on the part of some unofficial "searcher" to return the copy to the proper place.

If there are those who have had the courage to peruse this article up to this point, they are entitled to be relieved, for the moment, by the telling of a good story—a true one.

A well known Washington Trade-Mark Specialist was instructed to search a trade-mark. He advised that it had been registered. Later the prospective adopter visited Washington and was shown the copy in the file. Upon his return from Washington he instructed the specialist to file an application regardless of the prior registration. The application was rejected. Upon being so informed, the applicant replied "How in — did the Patent Office find the registered mark? I took the copy away with me when I was in Washington."

If there are, among the readers of this article, regular practitioners who have never experienced the misfortune attendant upon the deprivation of the benefits which would accrue from a public disclosure, in an easily accessible place and by practical means, of "Published" trade-marks, such a situation may best be illustrated by a somewhat analogous case. Would it not be a misfortune to be deprived of a knowledge of the contents of deeds, which have been presented to the Registrar of Deeds for recording, and have been duly marked for record and thereafter filed away without indexing in the private files of the recorder for a period of months pending a final registration? The answer is obvious; it would not only be a misfortune but it would also give evidence of fatal defectiveness in the recording system.

Inconsistency in Patent Office Filing.

Still another charge can be brought against the Patent Office filing system; namely, that the method of filing employed, as between "word" and "picture" trade-marks is inconsistent, on the grounds that whereas "word" trade-marks are filed under the "Vowel-Consonant" system, "picture" trade-marks are virtually filed under the "Consonant" system.

Consonants are the essential elements of words; vowels are the non-essential. The system of writing short-hand supports this proposition.

With respect to pictures, features which identify the object are the essential elements; specific details are the non-essential.

As has been shown, the location of a "word" trade-mark in the Patent Office file is largely determined by a nonessential element, that is, the vowel which usually immediately follows the initial letter. On the other hand, the location of a "picture" trade-mark is determined by essential elements,—as it should be.

For example, suppose it is desired to find a trade-mark comprising a dog's head with a collar. To be consistent the Patent Office should file the mark under "DOG," subclass "COLLARS," as it would file a word having the initial letter "N" followed by "A" among words commencing with "NA," or if followed by "E" among words commencing with "NE." But in fact no such consistent subclass "COLLARS" exists. Instead of being discovered in a subclass under "DOGS" the picture would be found under "DOGS" unsegregated, where it had been placed by the filing clerk, who after observing the picture decided that the essential elements identified the subject matter as a dog.

It may be asked why different subclasses were not created; for example, subclasses for dogs wearing "Collars," "Muzzles," "Blankets," and for "Long-eared" and "Short-legged" Dogs, etc., to overcome the necessity of looking through all the dog pictures if one were seeking to find the picture of a dog so differentiated.

The answer is obvious. If the pictures of dogs heads were filed in separate places, depending upon the exist-

ence of one or more of these non-essential elements, such a practice would defeat the primary object of filing trade-marks, which is, to disclose upon search not only the identical picture but similar pictures, inasmuch as all of the non-essential features which differentiate the picture of one dog from another, might not occur to the searcher, as for example, the picture of a dog wearing a "Blanket"; just as a person in searching the trade-mark "SINOL" under the "vowel-consonant" system employed by the Patent Office might not find "SHYNOL," from which it was necessarily separated, because of the difference in the non-essential elements "i" and "hy."

How to Remedy Defects.

It is respectfully submitted that if the Search Rooms of the Trade-Mark Division of the Patent Office were provided with two complete files of word trade-marks which would include both "published" and "registered" marks, one file utilizing the "Consonant" and the other the "Vowel-Consonant" system of filing, each file duplicating the words filed in the other, misspelled words would be revealed with more certainty. Furthermore, either file could be used as a check against errors in the other. This method would correct errors of omission,—failing to file a mark anywhere,—or of commission—filing incorrectly,—whether the error was made by the original official Patent Office filer, or the later unofficial filers,—the attorneys—in replacing the copies after making their searches.

I can assure the reader that a feeling of relief always comes over me when, after failing to discover a word in my "Consonant" file, the result of my search is corroborated by a consultation of my "Industry" file; because I realize the fallibility of human effort.

Whether it would be wise to divide the present Patent Office files into Classes is a moot question. However, without such division, the benefit of using one file to check the other is somewhat reduced; for without such division, a positive check on the "Consonant" file would necessitate either consulting every trade-mark in eighty-five drawers of the "Vowel-Consonant" file of the Patent Office, if the word to be searched commenced with the

letter "S," (for, there are approximately 15,000 such words registered), even though the number of words in the whole Class was small, or consulting the private file of an Examiner.

If the object of a public file of trade-marks located in the Patent Office is primarily to safeguard trade-mark adopters from unnecessary controversy, could there be any more convincing proof of the desirability, nay, the absolute necessity, of filing for reference "published" as well as "registered" trade-marks, than is disclosed by the following "YANKEE" trade-mark cases for candy. Let us set forth the facts categorically and thereby make them more clear.

(1) "YANKEE" filed July 21, 1906 by Henry Heide. Published May 13, 1913. First use claimed since 1890. Mark published May 13, 1913.

(2) "YANKEE" filed December 27, 1910 by T. M. Paist. Published September 5, 1911. First use May 1906.

(3) "YANKEE" filed June 24, 1910 by Webers. Published September 12, 1911. First use April 7, 1910.

(4) "YANKEE" filed by Windsor Chocolate Co. Not published but put in interference.

(5) Heide was given a favorable decision over the other applicants and a prior registrant and his application matured into registration July 29, 1913.

From the foregoing the reader will note that from September 5, 1911 until, July 29, 1913, nearly two years, the trade-mark adopting candy trader and his attorney were without available means of discovering the several pitfalls in the pathway leading to registration had an application been filed for the registration of "YANKEE" for candy.

But it is to the "TANGO" candy cases we should turn for the most glaring examples—in so far as the writer is aware—of *exposed* yet *hidden* trade-mark applications. The following data tells its own story.

Observe that not a single applicant, with the exception of the eventual registrant, claimed a date of first use prior to that claimed by the first applicant; and that the latter date had been disclosed to the world by publication in the PATENT GAZETTE even before the filing date of any subsequent applicant. Also observe that more

than three years intervened between the date of publication of the first applicant's mark and the date of registration by the successful applicant.

Did any of these applicants fall into the "Failure-of-the-Patent Office-to-file-and-index-published-trade-marks PITFALL?" It is feared they did. It is also interesting to conjecture whether the publication of the "TANGORENE" application (see inside back cover) escaped the eye of the attorney for the registrant, owing to the fact that the Patent Office has no public file where such may be found.

"Tango" Candy Cases.

Ser. No.	First Use	Filed	Published	Registered
71,364	6-11-1913	6-25-1913	10-10-1913	
74,224	10- 1-1913	11-26-1913	2-10-1914	
75,426	4-19-1913	1-26-1914	12- 5-1916	2- 6-17
77,414	12-20-1913	4-11-1914	8-11-1914	
79,146	5-15-1914	6-16-1914	7-21-1914	
81,652	6- 1-1914	10- 3-1914	12-15-1914	
82,627	1-23-1914	11-16-1914	1-26-1915	
82,783	8- 6-1914	11-23-1914	3-30-1915	

A Recent Concrete Example.

As this article is about to be sent to the editor, another concrete example has come to the writer's notice, and an incident in the present is much more convincing than tales of the past. A manufacturer of the "latest" in hot air furnaces—the single pipe type—originated a word as a brand name for his furnace, and had the name "searched" through his regular counsel, who employed a Washington associate. The report stated that no anticipation had been found.

The adopted word was cut into the patterns and hundreds of parts were cast. An advertising agency was then instructed to prepare an advertising campaign, which contemplated the preparation of many artist's drawings, an expensive catalogue, and country-wide display advertisements, and in which the new word would be prominently featured. Following the custom of the agency, the trade-mark was referred to me, and I found that the same word—a mighty good word for a furnace, significant yet not descriptive—had been published nearly three months.

In this case, my file saved the expense of drawings, catalogues and a controversy; but a similar file in the *Patent Office* would have saved the thousands of dollars worth of castings, which had to be thrown away, as well as other expense.

Money Not Lacking for Improvement.

Because of its failure to provide a file of "Published" trade-marks, the U. S. Government inferentially assumes the attitude that although it *is willing* to print in the OFFICIAL GAZETTE in excess of 1300 pages per year, in which appear over 10,000 reproductions of trade-marks applied for, (1920 figures), it is unwilling to provide a practical means whereby a prospective trade-mark adopter may discover whether or not his mark is among the 4000 to 5000 marks continuously in the condition called "Published"; that is, accepted but not issued; notwithstanding the fact that the trade-mark division of the Patent Office netted the surprising net profit of \$70,000 in the year 1920. Since the weekly issues of the GAZETTE are scanned by attorneys largely for the benefit of the trade-mark adopter who has not deemed it worth his trouble to register his mark, the advantage gained from the list of "Published" marks falls to the owner of such marks, for he may then oppose the registration of another user who is ignorant of the prior adoption and use of the unregistered mark. Thus the trade-mark adopter who does desire to register his mark is put in a very disadvantageous position; and it would seem, therefore, that the Government was intensely interested in the *user* of a trade-mark who fails to put his mark on notice by means of Patent Office registration, but was quite indifferent toward the *prospective user* who desires to keep out of trade-mark controversy and to register his mark.

Conclusion.

In summing up, it is submitted that the experiences of the writer are sufficient to prove the existence of two vital defects in the filing system of the Patent Office:

first, the employment of the unsatisfactory and inefficient "Vowel-Consonant" system, in preference to the more modern and highly efficient "Consonant" system; and second, the failure to provide a file of "Published" marks. But it is also believed that this evidence will be substantiated by the personal experiences of the reader of this article.

If the Patent Office would install the "Consonant" filing system, to assist searchers; and provide an indexed file of "Published" trade-marks; the Government could then offer to a deserving public a "Fourfold-Duty" trade-mark service. Its fourfold function would be:

- (1) to disclose the known word,
- (2) to expose different spellings of the known word and to reveal similar words,
- (3) to make "Published" and "Registered" trade-marks equally accessible, and
- (4) to check error or omission in one file against the other.

Would not this be preferable to the "Single-Duty" system of the present, which because of its inadequacy, is costing the business men of the country untold needless expense?

"Things are not always what they seem,
Skimmed milk masquerades as cream."

—PINAFORÉ.

Ser. No. 81,852. (CLASS 46. FOODS AND INGREDIENTS OF FOODS.) SHOWLEY Bugs, San Diego, Cal. Filed Oct. 3, 1914.

TANGORENE

Particular description of goods.—Candy. Claims use since June 1, 1914.

Ser. No. 79,146. (CLASS 46. FOODS AND INGREDIENTS OF FOODS.) CHOCOLATE PRODUCTS COMPANY, Baltimore, Md. Filed June 16, 1914.



Particular description of goods.—Chocolate Covered Nut-Candy. Claims use since May 15, 1914.

Ser. No. 71,364. (CLASS 46. FOODS AND INGREDIENTS OF FOODS.) NOVELTY CANDY CO., New York, N. Y. Filed June 23, 1912.

VIOLET TANGOS

The word "Violet" being disclaimed. Particular description of goods.—Candy. Claims use since June 11, 1913.

Ser. No. 82,627. (CLASS 46. FOODS AND INGREDIENTS OF FOODS.) PARK & TILFORD, New York, N. Y. Filed Nov. 16, 1914.

TANGO

Particular description of goods.—Candies and Chocolates. Claims use since Jan. 23, 1914.

Ser. No. 75,426. (CLASS 46. FOODS AND INGREDIENTS OF FOODS.) BUNTS BROTHERS, Chicago, Ill. Filed Jan. 26, 1914.

TANGOS

Particular description of goods.—Candy. Claims use since about the 19th day of April, 1913.

Ser. No. 77,414. (CLASS 46. FOODS AND INGREDIENTS OF FOODS.) WILLIAM C. GAGNON, Huron, S. D. Filed Apr. 11, 1914.



The words "Nutty" and "Bar" and "Gagnon" not being claimed. Particular description of goods.—Candy. Claims use since Dec. 20, 1913.

Ser. No. 82,783. (CLASS 46. FOODS AND INGREDIENTS OF FOODS.) EMERY & COMPANY, INCORPORATED Boston, Mass. Filed Nov. 23, 1914.



Particular description of goods.—Cake. Claims use since on or about Aug. 6, 1914.

Ser. No. 74,224. (CLASS 46. FOODS AND INGREDIENTS OF FOODS.) WOOLFOLK COFFEE CO., Lexington, Ky. Filed Nov. 26, 1913.



Particular description of goods.—Popcorn-Crisp. Claims use since Oct. 1, 1913.

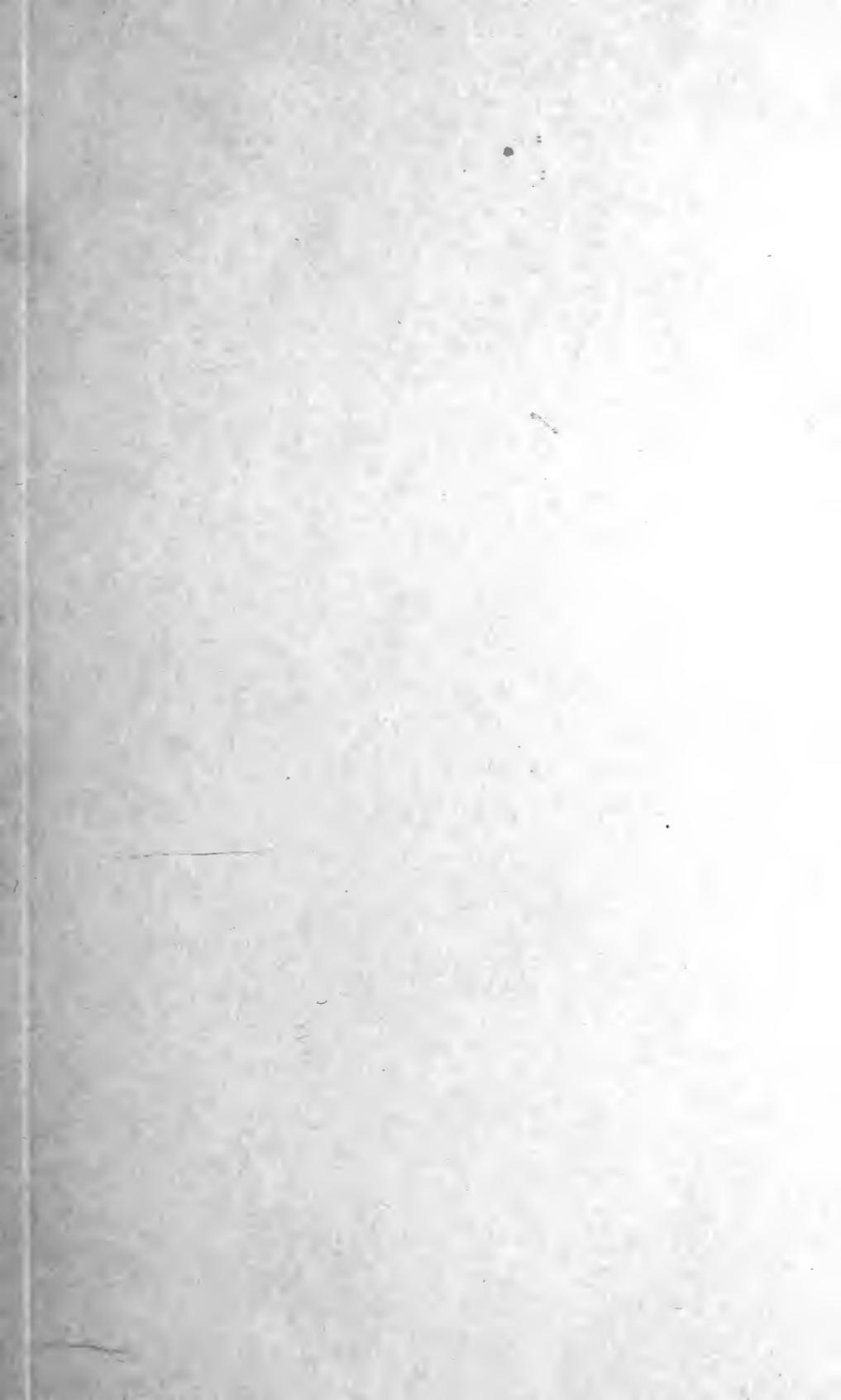
Marks Involved in the Historic "TANGO" Candy Interference.

An illuminating example of conditions resulting from the failure of the Patent Office to file and index Trade-Mark applications which have been made public by publication in the Official Gazette. While all of the above candy marks are in the writer's file, none of them, except "Tangorene," which singularly enough was not asked to be placed in Interference, was to be found in the Patent Office files from October 10, 1913 until February 2, 1917. (See page 26.)

LIBRARY OF CONGRESS



0 019 918 044 7



LIBRARY OF CONGRESS



0 019 918 044 7